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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/532,315

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EXAMINER

FISCHER, JUSTIN R

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

05/08/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/532,315	Applicant(s) OGAWA, YUICHIRO	
	Examiner Justin R. Fischer	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 8-14 and 16-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 15 is/are rejected.
- 7) ☒ Claim(s) 3-7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Nakagawa (JP 09001694). As best depicted in Figures 1A and 1B, Nakagawa teaches a tire construction comprising a first color sidewall 16B, a pair of second color sidewall rubber layers 16A, and a cover rubber layer 17. It is further noted that the manner in which the first and second sidewall rubber layers are applied does not further define the structure of the claimed tire article. It is emphasized that the claims are in a "product-by-process" form and determination of patentability is based on the product itself (see MPEP 2113).
3. Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Endo (JP 4-275136). As best depicted in Figures 1-4, Endo teaches a tire construction comprising a first colored sidewall a2, a pair of second color sidewall rubber layers a1,a3, and a cover rubber layer a4, wherein the cover rubber layer is buffed in order to expose the underlying first colored sidewall. It is emphasized that the claims are in a "product-by-process" form and determination of patentability is based on the product itself (see MPEP 2113).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Endo as applied above and further in view of Tanaka (JP 2002-79590) and optionally in view of Ikeda (US 2002/0074077). Endo is directed to a method in which a cover rubber a4 is positioned to cover a first colored sidewall rubber a2 and a pair of second colored sidewall rubber layers a1,a3. The method of Endo further includes the steps of vulcanizing the tire in a mold having a recessed part to accommodate a projecting portion of the tire and subsequently buffing the surface of the tire to expose the first colored sidewall. The reference, however, is completely silent with respect to the manner in which the first and second colored sidewall portions are applied to the tire. In any event, the general technique of forming such layers by winding rubber layers in successive turns is extremely well known and conventional in the tire industry, as shown for example by Tanaka. It is emphasized that the layers are generally applied in one of two manners (spiral winding or as single pieces) and applicant has not provided a conclusive showing of unexpected results to establish a criticality for the claimed method.

Also, as depicted in Figure 4, cover rubber layer a4 is depicted as a single, continuous layer or film. Additionally, Ikeda is optionally applied to specifically evidence

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a tire construction in which a single, continuous sidewall strip or layer is positioned axially outward of a sidewall layer formed by winding a strip in plural turns (Paragraph 78- combination of fiber tape wound layer Gsin and rubber strip Gs). Thus, the claimed combination of sidewall rubber layers is consistent with known techniques in the tire industry.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Endo and Tanaka as applied in claim 1 above and further in view of the APA (Paragraph 84).

While Endo is silent as to the method in which the cover rubber layer is applied, the APA describes the claimed method as constituting a known method of winding rubber ribbons. As such, one of ordinary skill in the art at the time of the invention would have found it obvious to apply the cover rubber layer of Endo in accordance to the claimed invention.

Allowable Subject Matter

7. Claims 3-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed February 10, 2009 have been fully considered but they are not persuasive.

Applicant argues that Nakagawa and Endo are silent about how the sidewall portions are applied. The examiner agrees. However, as detailed above, the claims are in a "product-by-process" form and determination of patentability is based on the

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product itself (see MPEP 2113), there being no evidence that the disclosed process results in a materially different article. It is emphasized that the particular method in which the respective layers are applied does not further define the claimed tire article.

As to claim 1, applicant argues that Paragraphs 8 and 9 discuss the problem of winding the colored sidewall portions and the cover rubber. First, as detailed above, cover rubber layer a4 is depicted as being a single, continuous layer. Second, in regards to the first and second sidewall portions, the figures generally depict the inclusion of said layers without any suggestion as to how they are applied. In view of Tanaka, one of ordinary skill in the art at the time of the invention would have been amply motivated to form said layers by winding a rubber tape (reduces cracking). Ikeda has been further applied to evidence the known use of an innermost tape wound sidewall rubber layer and an outermost sidewall rubber layer formed as a single, continuous layer or strip. The description in Paragraphs 8 and 9 are not seen to constitute a conclusive showing of unexpected results since they would naturally flow from following the prior art references of record. It is emphasized that there are only two ways to apply an outermost cover rubber layer to underlying sidewall rubber layers and the purported benefits listed in the aforementioned paragraphs do not constitute a conclusive showing of unexpected results.

Applicant contends that neither Endo nor Tanaka recognize an improvement in appearance. First, it is not required for a reference to expressly recognize the benefits associated with applicant's invention. Second, there are only two ways to apply an outermost cover rubber layer adjacent a sidewall rubber layer formed by winding a

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rubber tape and Ikeda recognizes each of application methods (single strip or plural windings of a tape- Paragraph 78). It is further emphasized that applicant's purported benefits do not constitute a conclusive showing of unexpected results.

Lastly, regarding claim 2, applicant argues that the APA does not address the above-discussed problems and thus, the claim should be allowable at least for its dependence on allowable claim 1. As detailed above, however, it is not required for the APA to expressly recognize applicant's purported benefits. In this case, the benefits would be expected to naturally flow from the teachings of the prior art references of record (benefits appear to be directly related to application method and such a method is obvious in view of the prior art reference of record).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Justin R. Fischer** whose telephone number is **(571) 272-1215**. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Justin Fischer
/Justin R Fischer/
Primary Examiner, Art Unit 1791
May 7, 2009